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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/056,188 | 01/24/2002 | Rajindra Aneja | 4020.000582 | 5007 |

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT PAPER NUMBER

1618

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,188

Applicant(s)

ANEJA, RAJINDRA

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22, 23, 31, 34, 35, 44-46 is/are allowed.
- 6) ☒ Claim(s) 21, 24-30, 32, 33, 36-43 and 47-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/20/05 wherein claims 1-20 are canceled; claims 21, 22, 24, 25, 26, and 53 are amended; and claims 55 and 56 are added.

Note: Clams 21-56 are pending.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

2. The Applicant's arguments filed 6/20/05 to the rejection of claims 21-29, 31, and 34-54 made by the Examiner under 35 USC 112 and double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

112 First Paragraph Rejection (New Matter)

I. The rejection of claims 25, 27, 28, 29, 38, 39, 42, 43, 47-52, and 54-56 under 35 USC 112, first paragraph, as failing to comply with the written description requirement is MAINTAINED for reasons of record in the office action mailed 2/18/05 and those set forth below.

Applicant asserts that the claims do not contain new matter because while the specification discloses the formula on page 5, on page 4, lines 25-29, it is disclose that the instant invention is directed to analogs which include, but are not limited to structural and stereochemical isomers of cellular phosphoinositides and their corresponding thiophosphates and phosphonates and the radyl and spingo type inositolphospholipids.

Applicant argument is not found persuasive because a broad recitation of closely related compounds does not provide a showing of the additional CH₂ group at the 3'-

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position. Thus, there is no indication that Applicant envisioned such modification at the time the case was filed. Furthermore, no evidence is of record that indicates that 'closely related' describes the changes (the additional CH₂ group at the 3'-position) as set forth in the claims.

Note: The rejection was made on the basis that the structure appearing in the claims is inconsistent with that of the disclosure (see page 5, line 1). Specifically, in the structures of the claims, there are two CH₂ groups attached to the phosphorous instead of one CH₂ group as set forth in the disclosure.

II. The rejection over the other claims that initially appeared in the rejection is WITHDRAWN because Applicant amended the claims to overcome the rejection.

112 Second Paragraph Rejection

The rejection of claims 21, 24, 26, 30, 32, 33, 36, 37, 40, 41, and 53 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is MAINTAINED for reasons of record in the office action mailed 2/18/05 and those set forth below.

Applicant asserts that the claims are no longer indefinite because the phrases 'derivative thereof' have been replaced with clearer phrases (i.e., derivative of ceramide residue or derivative of sphingosine residue).

Applicant's argument is found non-persuasive because the phrases 'derivative of ceramide residue' and 'derivative of sphingosine residue' are no clearer than 'derivative

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thereof (of ceramide of sphingosine)'. In particular, it is unclear what portion of the parent structure remains in the derivative. For example, the removal of a CH₂ generates a derivative. Likewise, the removal of two OH groups in combination with PO₃ would also be a derivative. Hence, it is unclear what species Applicant is intending to be compatible with the instant invention. Applicant is respectfully requested to amend the claims so that one may readily ascertain what is being claimed.

Double Patenting Rejection

The double patenting rejection is WITHDRAWN because Applicant has submitted an acceptable terminal disclaimer.

ALLOWABLE CLAIMS

3. Claims 22, 23, 31, 34, 35, and 44-46 are allowable over the prior art of record for reasons of record in the office action mailed 2/18/05.

COMMENTS/NOTES

4. It is once again noted that no prior art has been cited against the instant invention; however, Applicant MUST address and overcome the 112 rejections above. The claims are distinguished over the prior art of record for reasons of record in the office action mailed 2/18/05.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
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September 2, 2005